

Appln. No. 10/003,011

Attorney Docket No. 8627-213  
Client Reference No. PA-5270-RFB**II. Remarks**

Reconsideration and re-examination of this application in view of the following remarks is herein respectfully requested.

Claims 1-22 remain pending.

***Claim Rejections - 35 U.S.C. §103(a)***

Claims 1, 2, and 4-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,695,813 to Boyle (Boyle) in view of U.S. Patent No. 5,681,347 to Cathcart, et al. (Cathcart).

Claim 1 recites "a control assembly disposed at a proximal end of said outer sheath and said proximal end portion of said elongate control member and in operative relation thereto for urging said grasping portion from a distal end of said outer sheath and retraction thereinto." As noted by the examiner, the Boyle reference does not teach the control assembly according to claim 1. Further, applicants submit that Boyle teaches away from such a control assembly.

The device taught in Boyle is a filter to be used in conjunction with a therapeutic interventional procedure such as balloon angioplasty or stenting. Accordingly, a balloon catheter or stent is advanced for deployment over the wireguide 18 after the sheath 48 is removed. This is further explained in column 4, lines 11-25 where particularly the restraining sheath 48 is retracted to deploy the assembly and a separate recovery sheath is used to retrieve the filter device. As such, Boyle teaches against urging the grasping portion from a distal end of the outer sheath and retraction thereinto. Maintaining the attachment of the restraining sheath for a control assembly, as provided in claim 1, would frustrate the purpose of the device provided in Boyle.

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Applicant suggests that a *prima facie* case for obviousness has not been established by the examiner. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP §2142. The examiner has not provided factual support that the subject matter of claim 1 would have been obvious at the time of the invention to a person of ordinary skill in the art. Rather, the references teach away from the combination. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.: Ex parte, Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Here, the references are incompatible and teach away from the combination. Accordingly, the combination is improper. Further, claims 2 and 4-7 depend from claim 1 and are patentable for at least the same reasons as given above in support of claim 1.

Claims 2 and 4-7 depend from claim 1 and are, therefore, patentable for at least the same reasons as claim 1.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boyle in view of Cathcart, in view of U. S. Patent No. 5,330,484 to Gunther, et al. (Gunther).

Claim 3 depends from claim 1 and is, therefore, patentable for at least the same reasons as claim 1.

Claims 8-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boyle in view of Cathcart, and in view of U.S. Patent No. 5,098,440 to Hillstead (Hillstead).

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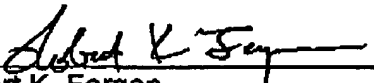
Claims 8-20 ultimately depend from claim 1 and are, therefore, patentable for at least the same reasons as given above in support of claim 1.

Claims 21 and 22 include the same elements noted above with respect to claim 1 related to the control assembly and, therefore, the same arguments given above in support of claim 1 are equally applicable to claims 21 and 22. Further, Hillstead does not teach or suggest the missing elements noted above. Accordingly, applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103.

*Conclusion*

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims are patentably distinguishable over the art of record and that this application is now in condition for allowance. Such action is respectfully requested.

Respectfully submitted by,

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